PATENT

Attorney Docket No.: 026595-005900US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS

In re application of:	Confirmation No. 7212
Mark Thompson et al.	Examiner: Lashonda T. Jacobs
Application No.: 10/032,796	Technology Center/Art Unit: 2157
Filed: December 26, 2001	REPLY BRIEF UNDER 37 CFR § 41.37
For: FORMS AUDITING SYSTEMS AND METHODS	
Customer No.: 20350	

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Sir:

     Appellants offer this Reply Brief in response to the Examiner's Answer mailed October 6, 2008 ("Examiner's Answer"). The following remarks are intended to further focus the issues in this appeal.

Remarks

     In response to the arguments in the Examiner's Answer, Appellants wish to address a number of issues raised therein. In the Answer, independent claims 1, 11, and 16 remained rejected under 35 U.S.C §102(e) as anticipated by U.S. Patent No. 6,185,583 to Blando ("Blando"). As a threshold matter, it is worth noting that the Federal Circuit recently reaffirmed that "unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to ... anticipate under 35 U.S.C. § 102." Net MoneyIn, Inc. v. Verisign, No. 2007-1565 (Fed. Cir. 10/20/2008).

The *(9) Grounds of Rejection* section of the Examiner's Answer is an almost verbatim copy of the rejection from the last Office Action dated April 30, 2008. Thus, this Reply will focus of the *(10) Response to Argument* section of the Examiner's Answer.

As noted in the Appeal Brief, the independent claims each set forth a system or method for auditing whether a particular form is valid (e.g., checking to see if the form being used is the updated or current version of the form). By way of example, the process may be initiated with a request to audit a form (e.g., made by issuing a request to provide a form identifier associated with a form being used). Then, as claim 16 specifically recites, a host computer is configured to "receive the form identifier in response to the request, and to verify whether the form identifier is a valid form identifier for the form to be audited by comparing the form identifier with the valid form identifiers in the database." Claims 1 and 11 include a similar limitations.

More specifically, the references cannot be relied upon to teach or suggest a host computer that 1) "receives a form identifier in response to a request to audit a form" or 2) "verifies whether the form identifier is a valid form identifier for the form to be audited," as recited in claim 16. Similar limitations are also found in both independent claims 1 and 11.

The Examiner's Answer errs in relying on Blando to teach these limitations. Blando's description shares similar *terminology* with the claims, but the identified *functionality* of the claims is plainly absent. Unlike the identified limitations of the claims, the Office relies on a part of the Blando reference that instead describes a "field identifier" for checking to confirm that a form has the correct "type of data and placement of data in the fields." Blando, col. 2, ll. 53-54. But then the Office also identifies a *different set of identifiers* in Blando to see whether an order type is a valid order type and includes the necessary forms. Id., col. 3, l. 66 - col. 4, l. 9. Blando's process involves using one set of identifiers to verify data in forms, then using a different set of identifiers to determine the type of an order and whether the order contains all necessary forms. But these portions alone, and together, fall far short of determining whether a current version of a form is being used by verifying whether a particular *form identifier* is a valid identifier for a particular form being used.

1. Receiving Form Identifier: As noted above, in claim 16 a host computer is configured to "receive a form identifier in response to a request to audit a form." The Examiner's Answer errs in stating that the "field identifiers" in Blando teach the *form identifier* of the claims. Examiner's Answer, p. 6, l. 19, citing Blando, co. 2, ll. 44-54. Blando describes a system including a database holding "field identifiers" that "represent data fields in . . . forms," such as name and address fields. Id. col. 2, ll. 50-52. The system then confirms that the data in such fields is in the proper format. Id. col. 3, ll. 1-17. The field identifiers of Blando simply do not teach or suggest the form identifiers of claims 1, 11, or 16.

Examiner's Answer also cites the comparison of "a request type field and activity code field included in the form to valid types of orders in rules database 150" as teaching the *form identifiers* in the claims. Examiner's Answer, p. 6, l. 19-20, citing Blando, co. 3, ll. 53-67. But the request type field and activity code field appear to identify the type of order, and do not identify the form version being used. It appears that the request type field and activity code field are used to identify the validity of orders, not whether a particular form is valid. The determination regarding validity of a version of a form is plainly different than a determination of the validity of an order or order type.

Moreover, Blando fails to teach that an identifier is received in response to a request to audit a form Appellants are unable to discern who or what in Blando makes a request to audit a form. Nor does Blando appear to suggest that the form identifier is received in response to such a request. The Examiner's Answer simply fails to address these aspects of the limitation.

Even assuming, for purposes of argument, that each element could be found with Blando, it is clear that the limitations are not arranged or combined in the same way as recited in the claim, as required under Verisign. The Examiner clearly errs because there is no teaching in Blando that a *form identifier* be *received in response* to a *request* to *audit* a form.

2. Verifying Form Identifier: Claim 16 further recites that a host computer is configured to "verify whether the form identifier is a valid form identifier for the form to be

audited by comparing the form identifier with the valid form identifiers in the database." The
Office further errs in stating that this functionality is found in Blando. The Office simply relies
on the fact that the claims and Blando share terminology; however, the functionality of the
independent claims is again absent from Blando.

      As noted above, the Blando system determines whether the order type is valid.
Blando, col. 3, ll. 60-66. But determining whether an *order type* is *valid* is very different than
verifying if the *form identifier* (missing from Blando) is a valid form identifier for the form to be
audited. Blando goes on to provide that if the order type is valid, the system then determines
"which forms correspond to [the] order type" and "checks the received order for the presence of
all forms corresponding to the order type." Id. col. 4, ll. 4-8. But again, the functionality of the
claims remains absent. In the claims, the host uses a form identifier to verify whether a
particular version of a form is valid; whereas in this portion of Blando, the system ensures that
all forms for a particular order type are present.

      The Examiner's Answer asserts that in Blando "forms are compared to other
forms stored in a forms database." Examiner's Answer, p. 10, ll. 17-18). Instead, in Blando a
"request type field and activity code field included in the form [are compared to] to valid types
of orders in rules database 150." Blando, col. 3, ll. 64-66. There is also a determination
regarding which types of forms correspond to a particular order type. Id., col. 4, ll. 5-9. But
Blando does not teach that a form identifier be compared to valid form identifiers in a database
to determine that the particular version of a form is valid given the type of form being audited.

      The Office has clearly erred by asserting that the data validation and order
checking process of Blando teaches the forms auditing system of independent claims 1, 11, and
16. The audit of the claims determines whether there is a valid form identifier. In contrast,
Blando describes determining whether certain data on a form is valid, whether an order type is
valid, and whether an order contains all required forms.

      The request to audit the validity of a form, and the provision of a form identifier
in response thereto, are simply not present in Blando. Blando therefore fails to teach receiving

"a form identifier in response to a request to audit a form," as recited in claim 16. Moreover, Blando fails to teach verifying "whether the form identifier is a valid form identifier for the form to be audited," as recited in claim 16. Similar limitations are found in claims 1 and 11, and thus are also absent from Blando

As the cited reference fails to teach or suggest all of the recitations of independent claims 1, 11, and 16, Appellants submit that these claims are allowable. Claims 2-10 and 12-15, which depend from these independent claims, are allowable for at least the same reasons. Therefore, Appellants respectfully request that the rejection under 35 U.S.C. §102(e) and 103(a) be reversed.

CONCLUSION

Thus, for at least these reasons as well as the reasons stated in the Appellants' Appeal Brief, which are hereby incorporated by reference, it is believed that the above claims are entitled to allowance. Appellants respectfully ask the Board to reverse each of the rejections of the Examiner. Although Appellants believe no fee is due, please deduct from Deposit Account 20-1430 any fees that are due in association with the filing of this Reply Brief.

Respectfully submitted,
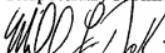
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